



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,205	02/01/2002	Kyeong Bae Park	0630-1423P	7510

2292 7590 08/12/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

NGUYEN, TRAN N

ART UNIT	PAPER NUMBER
----------	--------------

2834

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/060,205	PARK, KYEONG BAE	
	Examiner	Art Unit	
	Tran N. Nguyen	2834	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 4-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED OFFICE ACTION

Response to Applicant's Election with Traverse

The applicant's election, with traverse, of claims 4-13, filed on 5/23/03, is acknowledged. The traverse reasons provided by the applicant is not persuasive because of the following:

The applicant argues that the application may be required to be restricted if it contains two or more "independent and distinct" inventions claimed in one application. The applicant then explains that the term "independent", as set forth in MPEP j802.01, means that "there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". The term "distinct" means that "two or more subjects as disclosed are related, for example, as combination and part (sub-combination) thereof, ... and are patentable over each Other". Furthermore, the applicant states that the Examiner has set forth various reasons why the inventions are "distinct" from one another, by providing separate classifications for the groups, and by stating reasons why the groups are related. However, the Examiner has not met the burden of proving that the groupings are "independent" as required by the United States Code, the Code of Federal Regulations, and the Manual of Patent Examining Procedure.

In response to the applicant's argument, group I, the method claims containing claims 1-3, wherein claim 1 is an independent claim of the method of making a laminated core. On the other hand, group II, the structural claims containing claims 4-13, wherein claim 4 is the independent claims of the core lamination. These two groups of claims are independent from one another not as distinctly as combination and sub-combination as the applicant's example, but they are independently distinct in term of the process of making and the structure of the device.

The fields of search for a method of making a device and for a structure of the device, i.e., the product, are **not coextensive**, and determinations of patentability for claims of a method of making a device and claims of the device's structure **are different**.

Art Unit: 2834

In the determinations of patentability for claims of a method of making a device, the fabrication process includes its sequential order of fabricating steps and/or tools used in these steps of forming the device are considered significant.

On the contrary, in the determinations of patentability for claims of the device's structure the limitations of device's elements and their structural relationships as well as their functional/operational relationships are considered significant. In other words, in the device claimed invention, or in a product-by-process feature of a device, the method of forming the device is not germane to the issue of patentability of the device itself. (*In re Thorpe*, 227 USPQ 964, 966.)

Therefore, The fields of search for a method of making a device and for a structure of the device, i.e., the product, are not coextensive and the consideration for patentabilities are different and independent. This is the reason why there are two different and separate classifications for the method of forming the lamination core and the lamination core structure.

Thus, the restriction, which is set forth in the previous Office Action, is deemed to be proper and hereby made FINAL.

Election/Restriction

The applicant's election of claims 4-13 is acknowledged. However, within the structure claimed group, i.e., claims 4-13, contains claims directed to the following patentably distinct species of the claimed invention:

Species	Figures
1	4-8
2	9-11

Applicants are required under 35 U.S.C 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 4 is generic.

Art Unit: 2834

Applicants are advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. M.P.E.P. 809.02.

Applicants are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

Even though the claims are related but they represent different embodiments of different designed species. *There may be specific search areas that are required for particular claims that are not required for the others*; such search areas for this embodiment are not required for another embodiment. Evidently, there are two separately filed foreign applications have been submitted for foreign priority claimed for this single U.S. patent applications. The two foreign applications contain the two different inventions that are consolidated in this present application with various species of embodiments.

Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C 103 for the other invention.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

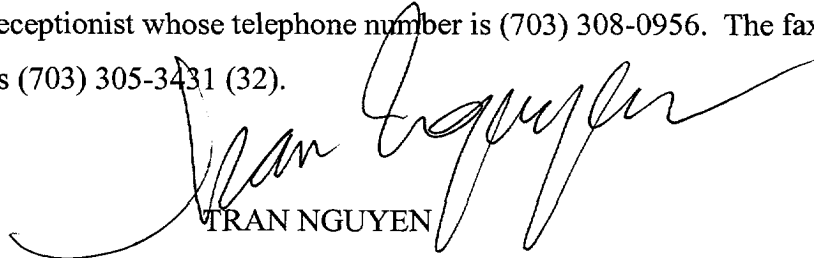
Art Unit: 2834

application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran Nguyen whose telephone number is (703) 308-1639.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-0956. The fax phone number for this Group is (703) 305-3431 (32).

A handwritten signature in black ink, appearing to read 'Tran Nguyen', is written over the printed name.

TRAN NGUYEN

PRIMARY PATENT EXAMINER

TC-2800